

### **REMARKS**

By this Amendment, Applicants amend claims 1, 18, and 20 to more appropriately define the present invention, and add new claims 22 and 23 to claim subject matter to which Applicants are entitled. No new matter is introduced. Claims 1-16 and 18-23 are now pending in this application.

In the Final Office Action mailed April 19, 2004, the Examiner rejected claims 1-5, 7-10, and 15-21 under 35 U.S.C. § 102(e) as anticipated by Tamano et al. (U.S. Patent No. 6,032,157) and also rejected claims 6 and 11-14 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme (U.S. Patent No. 5,848,373). Applicants respectfully traverse the rejections for at least the following reasons.

Regarding the rejection of claims 1-5, 7-10, and 15-21 under 35 U.S.C. § 102(e) as anticipated by Tamano, the Examiner has not established a *prima facie* case of anticipation. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8<sup>th</sup> ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8<sup>th</sup> ed. 2001), p. 2100-69.

Applicants' claim 1 recites a combination including, among other things, "receiv[ing] a user annotation at a first location on a first map; associat[ing] the user annotation with a set of first map coordinates using a georeferencing function of the first map; associat[ing] the set of first map coordinates with a set of second map coordinates

using a georeferencing function of the second map; and updat[ing] the second map with the user annotation at a location on the second map that corresponds to the first location.” Tamano does not disclose at least these features.

By contrast, Tamano discloses that image information linked with attribute information is referred to as first image information, and information that approximately corresponds to the first image information is referred to as second image information and is not linked to the attribute information. An object contained in the second image information is used as a key, and the attribute information linked with the first image information is retrieved by inputting a correspondence between the second image information and the first image information via the key, i.e., by selecting an object in the second image information. See col. 2, lines 41-52. In other words, an object is selected in the second image information. The selected object is linked to the same object appearing in the first image information. The system then retrieves attribute information that is linked to the object in the first image information.

To link images, Tamano, as shown in Fig. 3, discloses a link information table 30, which contains object numbers of the first image information 1 in a column 31, and coordinates of the objects in the first image information 1 in a column 32. In addition, object numbers of the second image information 2 are contained in a column 33, and coordinates of the objects in the second image information are contained in a column 34. The image numbers for first image information 1 are stored in the “IMAGE NO.” column 31 and the “X, Y” coordinates are stored in column 32. Predetermined values are also stored in the “IMAGE NO.” column 34 for second image information 2. See col.

5, lines 32-53. Therefore, Tamano discloses that a correspondence between objects of a first image and a second image is stored in link information table 30.

However, these teachings of Tamano do not constitute “receiv[ing] a user annotation at a first location on a first map; associat[ing] the user annotation with a set of first map coordinates using a georeferencing function of the first map; associat[ing] the set of first map coordinates with a set of second map coordinates using a georeferencing function of the second map; and updat[ing] the second map with the user annotation at a location on the second map that corresponds to the first location,” as recited in claim 1.

Instead, Tamano discloses using predetermined relationships between objects of a first image and a second image. When an object on the second map is selected, the selected object is linked to the same object appearing in the first image. The system then retrieves attribute information that links the objects in the two images. Accordingly, the Examiner has not demonstrated that Tamano discloses all of the features of claim 1. Applicants respectfully request the Examiner to withdraw the rejection of claim 1.

Independent claims 18 and 20, while of a different scope, include recitations similar to those discussed above in relation to allowable claim 1. The Examiner has referenced the rationale used regarding claim 1 to reject these claims. Claims 18 and 20 recite combinations including, among other things, “detecting an annotation entry on the first map; associating the annotation entry with a set of first map coordinates using a georeferencing function of the first map; associating the set of first map coordinates with a set of second map coordinates using a georeferencing function of the second map; and upon detecting the annotation entry, enabling display of the annotation entry on the

second map.” As discussed, Tamano does not disclose these features. Accordingly, the Examiner should also withdraw the rejection of claims 18 and 20 for at least the reasons discussed above.

Regarding claim 15, the Examiner alleges Tamano at col. 2, lines 40-66 discloses the elements of the claim. Applicants respectfully disagree. Claim 15 recites a combination including, among other things, “determining a boundary of a geographic region of a first map; converting the boundary of the geographic region of the first map into a corresponding boundary of a second map; and configuring the boundary of the second map for display.” Tamano does not disclose at least these features.

Tamano discloses that an object contained in the second image information is used as a key, and the attribute information linked with the first image information is retrieved by inputting a correspondence between the second image information and the first image information via the key, i.e., by selecting an object in the second image information. See col. 2, lines 41-52. However, these teachings of Tamano have no relation to the aforementioned steps of Applicants’ claim 15. Accordingly, the Examiner should withdraw the rejection of claim 15.

Regarding claim 16, the Examiner alleges Tamano discloses the features of the claims, and again cites to col. 2, lines 40-66. However, these teachings of Tamano, which were discussed above, also have no relation to claim 16. Claim 16 recites a combination including, among other things, “determining a boundary of a geographic region of a first map; converting the boundary of the geographic region of the first map into a corresponding boundary of a second map; [and] configuring the boundary of the second map for display.” Tamano does not disclose at least these features.

Accordingly, the Examiner should withdraw the rejection of claim 16 for at least this reason.

The Examiner also alleges steps of claim 16 are “inherent because in order to provide the right coordinates, one must convert the results of correlation from XY coordinates to georeferenced coordinate[s] and [vice] versa” (Office Action, page 6). Applicants respectfully traverse these allegations by the Examiner. Because the Examiner admits Tamano does not disclose the elements of these claims, the Examiner must show that the elements are inherently disclosed to substantiate a claim of anticipation. See In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). In particular, to establish inherency, the Examiner must specifically identify extrinsic evidence that makes clear to one skilled in the art that the missing element “is necessarily present” in the Tamano disclosure. See *id.*; see also Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991).

The Examiner has not met this burden. The Examiner instead speculates regarding Tamano, making unsupported conclusions regarding the reference without pointing to any extrinsic evidence that makes it clear to one skilled in the art that these elements are necessarily present. In fact, Tamano teaches away from the Examiner’s allegations because it discloses using predetermined values that link an object in a first image with an object in a second image instead of a conversion. The Examiner should withdraw the rejection of claim 16 for at least this additional reason.

Claims 2-5, 7-10, and 15-17; 19; and 21 depend from allowable claims 1, 18, and 20, respectively. At least due to their dependencies from allowable claims, and because these dependent claims include additional elements that are not disclosed by

Tamano, the Examiner should withdraw the rejection of claims 2-5, 7-10, 15-17, 19, and 21.

Regarding the rejection of claims 6 and 11-14 under 35 U.S.C. § 103(a) as unpatentable over Tamano, and in further view of DeLorme, Applicants respectfully submit that the Examiner has not demonstrated a *prima facie* case of obviousness. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must meet each of the following three requirements. First, the reference taken alone, or references combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, and not be based on applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

As discussed above, Tamano does not disclose or suggest all of the elements of claim 1. Claims 6 and 11-14 each depend directly or indirectly from claim 1. DeLorme discloses a computer aided map location system that provides correlation and coordination of spatially related data between a computer and a set of printed maps. However, DeLorme does not make up for the deficiencies of Tamano discussed above. At least due to their dependencies from allowable claims, and because these dependent claims include additional elements that are not disclosed by Tamano and DeLorme,

either taken alone or in combination, the Examiner should withdraw the rejection of claims 6 and 11-14.

Additionally, regarding claim 6, Applicants respectfully disagree with the Examiner's alleged motivation to combine Tamano and DeLorme. For example, the Examiner alleges it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of DeLorme into Tamano in order to update maps and geographical objects with the latest geographically related information in the first and second images of Tamano. (Office Action, page 8). The Examiner alleges this modification would be "beneficial to a user because of the portability of the equipment" (Office Action, page 8). However, the Examiner has not identified any suggestion or motivation arising from the references that would lead one of ordinary skill to combine the references in a manner resulting in the claimed invention. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Accordingly, the rejection is improper for at least this additional reason.

Regarding claims 11 and 12, the Examiner alleges that the network is the Internet is obvious because the network can be connected via a modem to the Internet. (Office Action, pages 8 and 9). Applicants respectfully submit that the rejection of these claims is improper because the Examiner has not shown that any teaching of a prior art reference discloses or suggests the features of these claims. Accordingly, the

Examiner should withdraw the rejection of claims 11 and 12 for at least this additional reason.

Finally, new claims 22 and 23 are directed to embodiments of Applicants' invention and are neither disclosed nor suggested by the cited prior art. Accordingly, the Examiner should allow new claims 22 and 23.

**CONCLUSION**


In view of the foregoing remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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